

**REMARKS**

In the Office Action<sup>1</sup>, the Examiner took the following actions:

rejected claims 83, 89-90, and 92 under 35 U.S.C. § 101 as being directed to non-statutory subject matter

rejected claims 83-84, 89-90, and 92 under 35 U.S.C. § 112 as being indefinite; and

rejected claims 83-84, 89-90, and 92 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent 6,553,000 to Ganesh et al. ("*Ganesh*").

Applicants have amended claim 83-84, 89-90, and 92. Claims 83-84, 89-90, and 92 remain pending.

**I. Rejection of claims 83-84, 89-90, and 92 under 35 U.S.C. § 101**

Regarding claims 83, 89, and 92, the Examiner states that "[t]he claims do not require any physical transformation and the invention as claimed do not produce a useful, concrete and tangible result." See Office Action, page 2. Applicant respectfully traverses this rejection and asserts that claims 83, 89, and 92 produce a useful, concrete, and tangible result. However, to expedite prosecution, Applicant has amended claims 83 and 89 to include "displaying at least one icon identifying the network service to be accessed, when the network service to be accessed is available," thus even more clearly producing a useful, concrete, and tangible result.

Regarding claim 92, Applicant asserts that the steps for determining eligible subject matter are set forth in the Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility (10/26/05) issued by the USPTO. The

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<sup>1</sup> The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

first step is to determine if the claim falls within four statutory categories (i.e., process, machine, manufacture, composition of matter). The second step is to determine if the claim recites an abstract idea, natural phenomenon, or law of nature. The third step is to determine if the claim is drawn to a practical application of the abstract idea, law of nature, or natural phenomenon. The final step is to determine if claim preempts every substantial practical application of abstract idea, law of nature, or natural phenomenon. As long as the claim falls within the four statutory categories and does not recite an abstract idea, natural phenomenon, or law of nature or preempt every substantial practical application of abstract idea, law of nature, or natural phenomenon, the claim is drawn to statutory subject matter.

Claims 92 is drawn to a distributed system. The distributed system includes a “server computer” that contains references to lookup services. The references are “received” by a “client computer” and the “client computer” stores the references in a “cache” associated with the “client computer.” The receiving of a reference and storing of the reference produces a useful, concrete, and tangible result. Therefore, claim 92 falls squarely within the categories of patentable subject matter. Applicant respectfully requests reconsideration and withdrawal of the rejection of claim 92 under 35 U.S.C. § 101.

The Examiner further rejects claims 89 and 90 as being directed to non-statutory subject matter and states that “Applicant’s specification includes carrier wave to be the computer-readable medium.” See Office Action, page 3. Applicant respectfully traverses this rejection. However, to expedite prosecution, Applicant has amended claim 89 to recite “a computer-readable storage medium containing instructions which

when executed on a data processing system, cause the data processing system to perform a method for accessing network services,” thereby reciting statutory subject matter even more clearly. Therefore, claim 89 falls within the categories of patentable subject matter, and Applicants respectfully request reconsideration and withdrawal of the rejection of claims 89 and 90 under 35 U.S.C. §101.

**II. Rejection of claims 83-84, 89-90, and 92 under 35 U.S.C. § 112**

Regarding claims 83, 89, and 92, the Examiner states that “it is unclear and indefinite who is receiving a request and who is sending the request, who is retrieving...from where a reference is received.” See Office Action, page 3. Applicant respectfully traverses this rejection and asserts that claims 83, 89, and 92 are not indefinite. However, to expedite prosecution, Applicant has amended claims 83, 89, and 92 to provide even greater clarity. Applicant therefore respectfully requests that the Examiner withdraw the rejection of claims 83, 89, and 92 under 35 U.S.C. § 112, second paragraph.

Regarding the rejection of claims 83 and 89, the Examiner states that there is insufficient antecedent basis for “from the cache.” See Office Action, page 3. Applicant respectfully traverses this rejection and asserts that sufficient antecedent basis for “from the cache,” is provided in line 3 of claim 83 and line 4 of claim 89. However, to expedite prosecution, Applicant has amended claims 83 and 89 to provide even clearer antecedent basis. Applicant therefore respectfully requests that the Examiner withdraw the rejection of claims 83 and 89 under 35 U.S.C. § 112, second paragraph.

**III. Rejection of claims 83-84, 89-90, and 92 under 35 U.S.C. § 102(e) as being as being anticipated by *Ganesh***

Applicant respectfully traverses the rejections of claims 83-84, 89-90, and 92 under 35 U.S.C. § 102(e), as being anticipated by *Ganesh*. In order to properly establish that *Ganesh* anticipates Applicant's claimed invention under 35 U.S.C. § 102, each and every element of each of the claims in issue must be found, either expressly described or under principles of inherency, in that single reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Claim 83 recites, among other things "retrieving, using the client lookup manager, a reference to a lookup service from the associated cache, wherein said lookup service is associated with said network service," and claim 92 recites a client computer which "stores said reference in the associated cache," (emphases added). *Ganesh* does not disclose at least these elements of Applicant's claimed invention.

In column 4 lines 30-33, *Ganesh* states that "[s]earch engine 48 is coupled to a memory 50 . Memory 50 stores a lookup table that search engine 48 uses for analyzing network frames received from media interface." In another part of *Ganesh* it is explained that:

"[i]n step 58, the media interface 46 receives a network frame from the network and passes the frame to search engine 48. The network frame contains a destination address that indicates the ultimate destination for the network frame. In step 60 , search engine 48 searches memory 50 to determine whether the destination address from the network frame is located within the lookup table of memory 50," (column 5, lines 22-50)

The search engine in *Ganesh* searches for a destination address for a network frame within the lookup tables of the memory. Such a disclosure does not constitute “retrieving, using the client lookup manager, a reference to a lookup service from the associated cache, wherein said lookup service is associated with said network service,” (emphases added), as recited in claim 83. In particular, such a disclosure does not teach retrieving “a reference to a lookup service” because in *Ganesh* the search engine searches for a destination address to forward the network frame and does not retrieve a reference to a lookup service.

The Examiner cites columns 6-8, lines 55-64 and Figures 6-7 as allegedly teaching the above-recited claim elements. The Examiner’s allegation is incorrect. As noted above, in *Ganesh* “the search engine checks whether an exact match is found between the destination address of the network frame and a network address within the look-up table. If an exact match is found, step 88 is executed to forward the network frame to the desired port.” (column 7, lines 27-31). Such a disclosure does not constitute “retrieving, using the client lookup manager, a reference to a lookup service from the associated cache, wherein said lookup service is associated with said network service, (emphases added),” as recited in claim 83. Even assuming that the searching for a destination address in *Ganesh* could constitute the claimed “retrieving” including “a reference to a lookup service” which Applicant does not concede, *Ganesh* teaches, at most, searching in lookup tables stored in a memory. However, such a disclosure does not constitute “retrieving, using the client lookup manager, a reference to a lookup service from the associated cache,” as required by claim 83 and a client computer that “stores said reference in the associated cache,” as required by claim 92 (emphases

added), because *Ganesh* does not teach having a client lookup manager with an associated cache and storing references in the cache. Neither columns 6-8 lines 55-64, nor any other part of *Ganesh* teaches retrieving from a “cache” or storing in a “cache.” Therefore, *Ganesh* does not teach or suggest the claimed elements including, retrieving, using the client lookup manager, a reference to a lookup service from the associated cache, wherein said lookup service is associated with said network service,” and a client computer which “stores said reference in the associated cache,” as required by claims 83 and 92 respectively (emphases added).

Accordingly, *Ganesh* cannot anticipate claims 83 and 92. Thus, claims 83 and 92 are allowable for at least these reasons.

Independent claim 89 while of different scope, recites elements similar to those of claim 83 and is thus allowable over *Ganesh* for at least the same reasons discussed above in regard to claim 83. Claims 84 and 90 are also allowable at least due to their dependence from claims 83 and 89 respectively.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the 35 U.S.C. § 102(e) rejection of claims 83-84, 89-90, and 92.

**CONCLUSION**

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.


Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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